

REMARKS

Reconsideration of this application is respectfully requested. Claims 1-4, 10-18 and 21-28 were pending in the application. Additionally, claims 5-9, 19-20, 29-32 and 35-36 were previously withdrawn s being non-elect species. Applicant understands that these previously withdrawn claims will be reinstated if a generic base claim is allowed. By the foregoing Amendment, claim 3 has been cancelled. Claims 37-41 have been added. Claims 1, 2, 18, 22, 27 and 28 have been amended. Claims 1-2, 4, 10-18, 21-28 and 37-41 remain pending in the application.

Rejection Under 35 USC § 112

Independent Claim 22, and claims 23-26 that depended therefrom, have been rejected under 35 USC, second paragraph for being indefinite. The indefiniteness cited was whether the claim was drawn to a combination of a purse hanger and a horizontal surface (a combination), or the purse hanger alone (a subcombination.) The Office Action advised that, in formulating the rejection on the merits, the Examiner considered that independent Claim 22 was drawn to the combination. Claim 22 has been amended to more clearly specify that it was directed to a combination.

Because independent Claim 22 is now definite, claims 23-26 which depend therefrom, are also definite. Applicant therefore respectfully requests that this rejection be withdrawn.

Claim Objections

Claims 2-3 have been objected to on the ground that it is improper to use a dependent claim to expand the scope of a claim from a subcombination to a combination. Claims 2 has been amended and now limited to the subcombination of the purse hanger. Claim 3 has been cancelled.

Claims 18 and 27-28 have been objected to for being written in means-plus-function language while including the term "means" without including the corresponding

function. Claims 18 and 27-28 have been amended to eliminate the objectionable recitations.

Objections to the Drawings

Within the Office Action, objection was made to the drawings for claiming a spring element in the purse engagement loop according to claims 21 and 26, but not having a figure from among the elected species that includes this feature and an element number referenced in the detailed description. The Office Action states, "the specification (page 14) describes the spring, but provides no reference number and does not show on Figures 1-4, 10 and 12-13 as elected." Applicant respectfully disagrees. Paragraph [0074] of the application recites:

According to the embodiment of FIG. 2, the movable loop member 72 is attached to the primary loop member 71 by a hinge74, and moves between the first and second positions in a swivel motion. *A spring 73* exerts a force between the primary loop member and the hinged member 72 to urge the hinged member to swivel to the closed position.

Because the referenced spring 73 is depicted and numbered in Fig. 2 of the elected species, Applicant respectfully requests that this objection be withdrawn.

Rejection Under 35 USC § 102

Claims 1-4, 13-18 and 22-25 have been rejected under 35 USC § 102 as being anticipated by Japanese Patent JP 10-113275 to Omura (hereinafter "Omura.") The responsive arguments set forth below are directed to the claims as amended.

Claim 1 recites,

A purse hanger comprising:

- a) a rigid interface member defining a planar interface area;
- b) ***a rigid arm with*** a proximal end coupled with the rigid interface member ***and a distal end configured to orient itself vertically beneath the planar interface area;*** and
- c) a flexible member with a first end coupled to the distal end of the rigid arm, and a second end coupled to a purse engagement member.

Attached herewith is a translation of Omura and a signed declaration by the translator. Assuming arguendo that the “iron bar” (element 3) of Omura is equivalent to the rigid arm of the present invention, and that element 1 (the “support:backing”) is equivalent to the rigid interface member of the present invention, element 2 of Omura is described as a “bearing, ball shaft” and element 5 is described as a “pivot.” These elements have the natural effect of allowing the “iron bar” of Omura to swing to a natural position of ninety degrees perpendicular to the “support:backing” (element 5) of Omura. For at least this reason, Omura does not disclose or suggest the limitation of ***a rigid arm with a distal end configured to orient itself vertically beneath the planar interface area***” as recited in claim 1, and is, in fact, teaching away from this limitation. In view of this clear distinction, neither claim 1, nor claims 2-4 and 13-18, which depend from and further limit claim 1, are anticipated by Omura.

Claim 22 recites in part:

a rigid arm with a proximal end coupled to said interface member and a distal end configured to orient itself vertically beneath said planar interface area when the planar interface area is resting on the horizontal surface

Applicant submits that, for at least the reasons given in conjunction with independent claim 1, Omura does not disclose or suggest the above recited limitations of independent claim 22, and that independent claim 22, and claims 23-25 which depend from and further limit claim 22, are therefore not anticipated by Omura.

Rejection Under 35 USC § 103

Claims 1-4, 10-11, 13-18 and 22-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over GB Patent No. 2,253,998 to Lurie et al. (hereinafter “Lurie”) in view of Omura. Applicant respectfully disagrees with the reasons for this rejection.

Claim 1 recites, in part,

a rigid arm with a proximal end coupled with the rigid interface member and a distal end configured to orient itself vertically beneath the planar interface area;

No motivation or suggestion to combine: As discussed above, the embodiment described in Omura comprises a pivotable “iron bar” suspended by a “ball bearing shaft 2” and a “pivot 5.” In contrast to the teachings of Omura, page 7 of Lurie discloses “As shown in FIGURE 2, support shaft 13 extends outwardly from sleeve 19 in parallel spaced relation to the lower planar surface 18 of the housing 12.” (Lurie, page 7, first full paragraph.) Because there is no suggestion or motivation within Omura or Lurie as to how their teachings can be combined, Applicant respectfully contends that the combination of Omura and Lurie does not establish a prima facie case for obviousness. *MPEP 706.02(j); Ex Parte Skinner* , 2 USPQ2d 1788, 1790 (B.P.A.I. 1986).

Inoperable reference teaches away from combination: Moreover, Applicant respectfully contends that Lurie is teaching away from Omura, and that the combination of Lurie and Omura would create an inoperable reference. As noted above, Lurie teaches a support shaft 13 that extends outwardly from sleeve 19 ***in parallel spaced relation to the lower planar surface*** 18 of the housing 12. For the support shaft to extend outwardly in a parallel spaced relation, *or in any fixed relation* to the lower planar surface necessarily requires that ***the support shaft of Lurie is fixed in relation to the lower planar surface of the housing***. This is confirmed by an examination of Figure 2 of Lurie. As also noted above, Omura teaches an iron bar coupled to element one (the support: backing) by *a pivot 5*. This necessarily requires that ***the iron bar of Omura is not fixed in relation*** to the planar surface of the housing (the “Support:Backing”) of Omura. Accordingly, Lurie is teaching away from Omura. References that are teaching away from each other cannot sustain a prima facie case for obviousness.

We have noted elsewhere, as a “useful general rule,” that references that teach away cannot serve to create a prima facie case for obviousness . . . if references taken in combination would produce a “seemingly inoperative of device,” we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.”

(McGlyney v. Franklin Sports Inc., 262 F. 3d 1339, 60 USPQ 2d 1001 (Fed. Cir. 2001); *In re Spinnoble*. 405 F. 2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969) (references teach away from combination in combination produces seemingly inoperative device); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

See also MPEP 706.02(j). For at least these reasons, Applicant submits that claim 1 is not obvious over a Lori in view of Omura. Because claims 2-4, 10-11 and 13-18 depend from, and further limit claim 1, claims 2-4, 10-11 and 13-18 are also not obvious in view of this combination.

Claim 22 recites, in part:

“a rigid arm with a proximal end coupled to said interface member and a distal end configured to orient itself vertically beneath said planar interface area when the planar interface area is resting on the horizontal surface”

As discussed above, there is no suggestion or motivation within Omura or Lurie to combine features of these two disclosures. Moreover, it is noted that the Lori reference teaches away from Omura, and that the combination creates an inoperable reference. For at least these reasons, Applicant submits that claim 22 is not obvious by Lurie in view of Omura. Because claims nor claims 23-25 depend from, and further limit claim 22, claims nor claims 23-25 are also not rendered obvious by Lurie in view of Omura.

Claims 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lurie in view of Omura, further in view of U.S. Pub. No. 2004/0195484 to Sheeran (hereinafter "Sheeran"). Applicant respectfully disagrees with the reasons for this rejection.

Claim 12 depends from claim 1, and therefore, necessarily includes the limitation:

a rigid arm with a proximal end coupled with the rigid interface member and a distal end configured to orient itself vertically beneath the planar interface area;

As discussed above, the teachings of Omura are expressly teaching away from Lurie, and, if combined, would create an inoperable reference, and destroy the very object of the Lurie invention. Therefore, Sheeran cannot possibly be combined with the teachings of Omura and Lurie to suggest the above recited limitation. For at least these reasons, claim 12 is not obvious over Lurie, in view of Omura, further in view of Sheeran.

Claims 27-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lurie in view of Omura, further in view of Sheeran. Applicant respectfully disagrees with the reasons for this rejection. Because claims 27-28 depend from, and further limit claim 22, they necessarily include the limitation,

“a rigid arm with a proximal end coupled to said interface member and a distal end configured to orient itself vertically beneath said planar interface area when the planar interface area is resting on the horizontal surface”

As discussed above, the teachings of Omura are expressly teaching away from Lurie, and, if combined, would create an inoperable reference, and destroy the very object of the Lurie invention. Therefore, Sheeran cannot possibly be combined with the teachings of Omura and Lurie to suggest the above recited limitation. For at least these reasons, claims 27-28 are not obvious over Lurie, in view of Omura, further in view of Sheeran.

Claims 21 and 26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Omura in view of U.S. Patent No. 6,557,329 to Schmidt (hereinafter "Schmidt"). Applicant respectfully disagrees with the reasons for this rejection.

Because claim 21 depends from, and further limit claim 1, claim 21 necessarily includes the limitation:

a rigid arm with a proximal end coupled with the rigid interface member and a distal end configured to orient itself vertically beneath the planar interface area;

As discussed above, the embodiment described in Omura comprises a pivotable “iron bar” suspended by a “ball bearing shaft 2” and a “pivot 5.” In contrast to the teachings of Omura, FIGS. 1 and 2 of Schmidt disclose a stud 20 integrally extending from the base 18 of the hook. The ring 22 is releasable mounted on the stud 20 by means of a hole 24 through the side wall of the ring 22. (Col. 1 line 63-col 2 line 4)

Because there is no suggestion or motivation within Omura or Schmidt as to how their teachings can be combined, Applicant respectfully contends that the combination of Omura and Schmidt does not establish a prima facie case for obviousness. MPEP 706.02(j). Moreover, Applicant respectfully contends that the rigid stud-in-hole structure disclosed in FIGS. 1 and 2 of Schmidt is ***teaching away*** from the pivot structure of Omura. Although an embodiment of Schmidt allows for the stud to swivel relative to the hole (Col. 1, lines 63-67), the stud cannot possibly pivot within the hole. To pivot the stud 20 within the hole 24 of Schmidt according to the teaching of Omura would either bend or break off the metal stud 20, or bend and destroy the hole 24.

the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the ***reasonable expectation of success*** must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP 706.02(j), emphasis added. For at least these reasons, Applicant submits that the combination of Omura and Schmidt does not render claim 22 obvious.

Claim 26 has also been rejected by the combination of Omura and Schmidt. Because claim 26 depends from, and further limits claim 22, claim 26 necessarily includes the limitation “***a rigid arm with a proximal end coupled to said interface member and a distal end configured to orient itself vertically beneath said planar interface area when the planar interface area is in a fixed horizontal orientation.***”

As discussed in reference to claim 22, there is no teaching or suggestion within either Omura or Schmidt as to how to combine their teachings. Therefore, a prima facie case of obviousness has not been met. Moreover, as noted, the rigid stud-in-hole structure disclosed in FIGS. 1 and 2 of Schmidt is teaching away from the pivot structure of Omura. As noted, to pivot the stud 20 within the hole 24 of Schmidt according to the teaching of Omura would either bend or break off the metal stud 20, or bend and destroy the hole 24 of the Schmidt apparatus. For at least these reasons, Applicant submits that the combination of Omura and Schmidt does not render claim 26 obvious.

New Claims:

Claims 37 – 40 have been added to the application, and stand allowable over the art cited within the Office Action for at least the reasons discussed above.

Reinstatement of Withdrawn Claims

In view of the above remarks, Applicant submits that Claims 1 and 22 stand in condition for allowance. Because independent Claims 1 and 22 provide a generic base claim for withdrawn claims 5-9 and 19-20, 29-32 and 35-36, Applicant respectfully requests that withdrawn claims 5-9 and 19-20, 29-32 and 35-36 be re-instated. Applicant notes that withdrawn claims 19 and 20 incorporate the term “slide means” without stating a function. Upon re-instatement of the withdrawn claims, Applicant invites the Examiner to offer an Examiner’s Amendment, substituting the term “sliding member” for the terms “slide means” in claims 19 and 20.

Conclusion:

In View of the above remarks, Applicant submits that Claims 1-2, 4-32 and 35-40 stand in condition for allowance, and requests notification allowance at Examiner's earliest convenience. If a telephone call would prove helpful, Applicant invites Examiner to contact Applicant, Lenna Bauerly at (310-985-0407) .

Respectfully submitted

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